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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,693	12/05/2003	Stephen H. Albertson	TRACKER.1C1DVI	9989
20995	7590	01/27/2006		
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			EXAMINER MITCHELL, KATHERINE W	
			ART UNIT	PAPER NUMBER
			3677	

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/728,693	Applicant(s) ALBERTSON ET AL.	
	Examiner Katherine W. Mitchell	Art Unit 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213:

Disposition of Claims

- 4) ☒ Claim(s) 2-4, 9, 13, 44 and 57-98 is/are pending in the application.
- 4a) Of the above claim(s) 2-4, 13, 44 and 57-89 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9 and 90-98 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 5 Dec 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/3/2006, 10/3/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 9 and 96-98 are objected to because of the following informalities:

In claim 9, line 4, --when-- needs to be inserted immediately after "exposed" and "then" needs to be deleted.

Claim 9, line 8, "inserting the fastener into an object" is confusing. Is applicant claiming that the person doing the inserting also does the coloring and correlating of colors?

Claim 96, 97, and 98, line 2 of each, "one" needs to be deleted.

Appropriate correction is required.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 1/3/2006 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered and initialed by the examiner.

Drawings

3. Figure 1A should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the

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applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. Examiner notes that certain fasteners in the claims are not shown - a screw, or a rivet, or a wedge anchor bolt. Any structural detail **that is essential for a proper understanding of the disclosed invention** should be shown in the drawing. MPEP § 608.02(d). However, examiner believes that anyone of ordinary skill in the art would know what a screw, a rivet, and a wedge anchor bolt look like, and thus their depiction is not necessary for a proper understanding of the disclosed invention. Since no additional features of the fasteners are claimed other than the fact that the fastener can be a screw, or a rivet, or a wedge anchor bolt, examiner **does not** consider the drawings to be deficient in this respect.

Claim Clarifications

5. Based on the interview with the applicant and inventor, and the phone interview on July 14, 2005 when examiner believed the case might be allowable, examiner believes "inserting the fastener into an object" is not intended to be in the independent claim, as it requires the inserter to also select, correlate, and apply the color to the fastener. Therefore, examiner is examining the claims as though it were not present.

6. If the inserting limitation is included, the claims would be allowable, subject to the correction of the claim objections above (except for canceling the inserting step).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 9,90,91,93,94, and 96-98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickson USP 5511917 in view of Schwartz USP 5181439.

Re claim 9: Dickson teaches a nail having a shaft and an exposed portion attached to the first end of the shaft and an identifying indicia, corresponding to at least two different fastener physical properties (length and gauge, Dickson column 5 lines 1-10 and 23-30), on the exposed portion easily recognizable by a person of normal vision. Dickson teaches in column 1 lines 60-67 that graphic indicia are desirable to allow building inspectors to quickly determine if a fastener is correct and meets code requirements. A color key with the correlation of colors with physical properties is inevitably taught by Dickson, as a key would be required for the device to work - how else could the installer or inspector referred to by Dickson use the indicia to identify physical properties of the fastener? However, Dickson is not clear that the identifier is a color that is recognizable by a person of normal vision from a distance of 18, and thus 10, feet when the shaft is inserted into a surface. Schwartz teaches in column 4 lines 4-25 that a fastener head may have all of at least the top surface of the fastener color-coded. Column 3 line 17 emphasizes that with this marking, a user can tell "at a glance" the indicated property. Also, examiner notes that since the colored top is the property allowing applicant's fastener to be recognizable at at least feet, any colored top would inevitably be recognizable by a person of normal vision from a distance of 10 feet

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when the shaft is inserted into a surface since it meets the same physical structure.

The method of using the fastener is taught by Dickson the abstract.

Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Dickson and Schwartz before him at the time the invention was made, to modify Dickson as taught by Schwartz to include coloring the tops of the fasteners to improve visibility, in order to obtain identification "at a glance". One would have been motivated to make such a combination because easily identifiable markings leading to faster and more accurate use of fasteners would have been obtained, as taught/suggested by Schwartz in column 1 lines 30-62, with column 3 lines 53-column 4 line 3 emphasize that the coloration be "readily seen" when the fastener is in place. Further, fasteners that can be easily matched with a corresponding component, such as a tool or substrate, would have been obtained, which would minimize construction errors and time.

Further, although examiner notes that Dickson is not specific that a single color represents a plurality of at least two physical properties of the fastener, Dickson does teach identifying multiple physical properties with indicia. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have used a single indicia for multiple properties, including two properties, since it has been held that mere duplication [and thus the combination] of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Re claims 90,91,93,94: Dickson teaches the fastener as a nail, bolt, screw, or rivet in column 3 lines 3-12.

Further regarding claims 96-98: Dickson teaches in column 5 lines 53-67 that additional symbols, such as a manufacturer's logo or trademark, or an orienting mark, can be added to the head of the fastener. A trademark is often specific to a particular material or property, and an orienting mark would serve to identify the fastener orientation. Further, it would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have used multiple indicia for multiple properties, including three properties, since it has been held that mere duplication [and thus the combination] of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

9. Claims 92 and 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickson USP 5511917 in view of Schwartz USP 5181439 and common knowledge in the art. As discussed above, Dickson in view of Schwartz teach all the elements except that the fastener can be a staple or wedge anchor bolt. Dickson is clear, in column 3 lines 3-13, that all "other fasteners are contemplated", and examiner takes Official Notice that staples and wedge anchor bolts are well known types of fasteners in the fastening art. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have included staples and wedge anchor bolts in the fasteners to have their properties identified, since the examiner takes Official Notice of the equivalence of nail, bolt, screw, staple, wedge anchor bolt, or rivet for their use in the fastener art and the selection of any of these

known equivalents to have their physical properties identified to ensure correct application usage would be within the level of ordinary skill in the art.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. This is a continuing examination (RCE) to have references listed on a PTO/SB/08 considered. All claims are drawn to the same invention claimed earlier and have not been amended. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after an RCE. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

12. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine W. Mitchell whose telephone number is 571-272-7069. The examiner can normally be reached on Mon - Thurs 10 AM - 8 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Katherine W Mitchell
Primary Examiner
Art Unit 3677

Kwm
1/11/2006

A handwritten signature in black ink, appearing to read "Katherine W Mitchell", written in a cursive style.